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EXAMINER

PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 08/26/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,772

Applicant(s)

KOVALES ET AL.

Examiner

Joseph T Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-91 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-91 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 91 objected to because of the following informalities: Claim 91 recites "computer program according to claim 33" but Claim 33 is a 'system' claim. Examiner replaced "according to claim 33" with "according to claim 57" which is a computer program claim. Appropriate clarification or correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1-10, 12-20, 22-38, 40-47, 49-91 rejected under 35**

U.S.C. 102(b) as being anticipated by Haddock, Patent #5,742,736.

4. **Claims 1, 33, and 57 rejected under 35 U.S.C. 102(e) as being anticipated by Tucker et al., Patent #6,055,495.**

Regarding claims 1, 33, and 57, Haddock and Tucker teaches a method, system and computer program product for providing at least one bookmark for a voice mail message by a caller leaving the voice mail message (Haddock col.3

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line 57-col.4 line 19; Tucker col.1 lines 4-26, col.2 lines 1-67, col.4 lines 1-40).

Regarding claims 2, 34, and 82 **Haddock** teaches a method, system and computer program product according to claims 1, 33, and 57 further comprising the step of creating a bookmarked message from the voice mail message and the at least one bookmark(*Haddock col.3 line 57-col.4 line 19*).

Regarding claim 3, 35, and 58, **Haddock** teaches a method, system and computer program product according to claims 2, 34, and 82 further comprising the step of playing the bookmarked message to a listener (*col.4 lines 1-54*).

Regarding claim 4, 36, and 59, **Haddock** teaches the method, system and computer program product according to claims 1, 33, and 57 wherein at least one bookmark segments the voice mail message according to one or more topics(*col.4 lines 16-54*).

Regarding claims 5 and 60, **Haddock** teaches the method, system and computer program product according to claims 1 and 57 wherein at least one bookmark is used to mark one or more segments of the voice mail message as having one or more different degrees of importance (*col.4 lines 8-67*).

Regarding claims 6 and 61, **Haddock** teaches the method, system and computer program product according to Claims 5, 37, and 57 wherein a default degree of importance is associated with segments not otherwise marked (*col.4 lines 8-67*).

Regarding claims 7, 37, and 62, **Haddock** teaches the method, system and computer program product according to claims 1, 33, and 57 wherein at least one bookmark corresponds to one or more special types of information in the

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voice mail message (col.4 lines 8-67).

Regarding claims 8-10, 38, 40, and 63-66 **Haddock** teaches the method, system and computer program product according to claims 7, 37, and 62 wherein at least one of the special types of information is one of a: callback telephone number for the caller; a callback time at which to respond to the voice mail message; a callback date on which to respond to the voice mail message; a name of the caller; a URL; an email address; or a protection/confidentiality indicator (col.4 lines 8-67).

Regarding claim 67 **Haddock** teaches a computer program product according to claim 59 further comprising code configured to use the at least one bookmark to navigate from one topic of the voicemail to another(col.4 lines 8-67).

Regarding claim 14, 41, and 68, **Haddock** teaches a method, system and computer program product according to claims 2, 34, and 58 further comprising the step of using the at least one bookmark to perform actions selectively on one or more segments of the voice mail message (col.4 lines 8-67).

Regarding claim 15, 42, and 69, **Haddock** teaches a method, system and computer program product according to claims 14, 41, and 68 wherein the selected segments are associated with a topic of the voice mail message(col.4 lines 8-67).

Regarding claim 16, 43, and 70, **Haddock** teaches a method, system and computer program product according to claims 14, 41, and 68 wherein the selected segments have one or more different degrees of importance(col.4 lines 8-67).

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Regarding claims 17, 47, and 72 **Haddock** teaches a method, system and computer program product according to claims 14, 41 and 68, wherein the selected segments are associated with one or more special types of information in the voice mail message(col.4 lines 8-67).

Regarding claim 18, 44, and 71, **Haddock** teaches a method, system and computer program product according to claims 14, 41, and 68, wherein the actions comprise one or more of saving, deleting, forwarding, listening, skipping, or repeating the one or more segments, and marking a particular segment as protected or confidential prior to forwarding the marked segment to another party (col.4 lines 8-67).

Regarding claim 19 and 45 **Haddock** teaches a method, system and computer program product according to claims 18 and 44, wherein the actions further comprise marking a selected segment as protected or confidential(col.4 lines 8-67).

Regarding claim 20 and 46 **Haddock** teaches a method, system and computer program product according to claims 19 and 45 further comprising forwarding the segment marked as protected or confidential to another party (col.4 lines 8-67 and col.7 lines 5-57).

Regarding claim 22 **Haddock** teaches the method according to claim 2, wherein the creating step further comprises storing the bookmarks and the voice mail message separately as the bookmarked message (col.4 lines 8-67).

Regarding claim 23 **Haddock** teaches the method according to claim 2 wherein the creating step further comprises storing the bookmarks and the voice

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mail message intermingled as the bookmarked message (col.4 lines 8-67).

Regarding claims 24, 49, and 74 Haddock teaches a method, system and computer program product according to claims 3, 5, 7, 35, 37, 43, 58, 60, and 62 further comprising announcing, before and/or after playing the voicemail message, a number of the bookmarked segments in the voicemail message(col.2 line 48-col.3 line 31, and col.4 lines 8-67).

Regarding claims 25-26, 50, 75, 83-86 Haddock teaches a method, system and computer program product according to claims 3, 5, 7, 35, 37, 43, 58, 60, and 62 further comprising announcing, before and after playing the voicemail message, the different degree of importance in the voice mail message and a number of segments thereof(col.2 line 48-col.3 line 31, and col.4 lines 8-67).

Regarding claims 27, 51, 76, 87-88 Haddock teaches a method, system and computer program product according to claims 3, 5, 7, 35, 37, 43, 58, 60, and 62 further comprising announcing, before and after playing the voicemail message, the special types of information in the voicemail message(col.2 line 48-col.3 line 31, and col.4 lines 8-67).

Regarding claims 28, 52, and 77 Haddock teaches the method, system and computer program product according to claims 7, 37, and 62 wherein particular ones of the special types of information are required, and further comprising the step of prompting the caller to provide input for each particular one for which no bookmark is otherwise provided (col.4 lines 8-67; when answering machine prompts caller to leave a message).

Regarding claims 29, 53, and 78 Haddock teaches the method, system and computer program product according to claims 2, 34, and 58 further comprising the step of associating one or more audio cues with one or more bookmarks of the voice mail message(col.4 lines 8-67).

Regarding claims 30, 54, and 79 Haddock teaches the method, system and computer program product according to claims 29, 53, and 78 further comprising the steps of playing the bookmarked message to a listener; and incorporating the one or more associated audio cues along with respective portions of the voice mail message corresponding to the one or more bookmarks (col.4 lines 8-67).

Regarding claims 31, 55, and 80 Haddock teaches the method, system and computer program product according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue with its respective portion of the voice mail message (col.4 lines 8-67).

Regarding claims 32, 56, and 81 Haddock teaches the method, system and computer program product according to claims 30, 54, and 79 wherein the step of incorporating the one or more associated audio cues further comprises incorporating each associated audio cue in-line with its respective portion of the voice mail message(col.4 lines 8-67).

Regarding claims 89-91 Haddock teaches a method, system and computer program product according to claims 1, 33, and 57 wherein the caller provides a plurality of bookmarks for the voice mail message (col.4 lines 8-67

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and col.5 lines 19-34).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 21, 39, 48, and 73 rejected under 35 U.S.C. 103(a) as being unpatentable over Haddock, Patent #6,625,261.

Regarding claims 11, 21, 39, 48, and 73 Haddock teaches a method, system and computer program product according to claims 17, 37, 47, and 72.

Haddock is silent on wherein at least one of the special types of information comprises a uniform resource locator(URL) and where at least one of the actions comprises automatically establishing a connection to the URL.

However Haddock's invention involves viewing and manipulating voice mail messages on a computer display and the contents thereof can be retrieved and connected to applications on the computer (col.4 lines 38-54).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to automatically establish a connection to a URL that is within a voicemail message.

One of ordinary skill in the art would have been motivated to do this as automatically connecting to a URL via a displayed hyperlink is old and well-known in the art and since Haddock's user is able to use information(e.g. phone

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#, points of interest, etc.) to automatically establish a connection to it, URL's are just an example of points of interest that can be accessed with a computer application(e.g. "Internet Explorer").

Response to Arguments

6. Applicant's arguments with respect to claims 1-81 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T Phan whose telephone number is

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703-305-3206. The examiner can normally be reached on M-TH 9:00-6:30, in every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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August 23, 2004

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Creighton Smith
Primary Examiner